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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1772
Examiner : Catherine A. Simone
Serial No. : 09/980,651
Filed : October 23, 2001
Inventors : Tetsuya Tsunekawa

Customer No.: 035811

Docket No.: 1319-01

Confirmation No.: 7108

: Masayoshi Asakura
: Tetsuya Yamagata
Title : POLYESTER FILM FOR HEAT-RESISTANT
: CAPACITOR, METALLIZED FILM THEREOF,
: AND HEAT-RESISTANT FILM CAPACITOR
: CONTAINING THE SAME

Dated: March 15, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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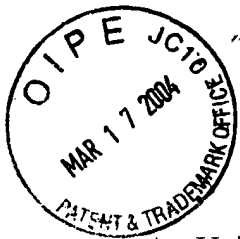
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Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

Piper Rudnick LLP
Customer No. 35811

By: 

Date: 15 MAR 2004



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RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is submitted in response to the Official Action dated December 1, 2003.

The Applicants note with appreciation the withdrawal of the §102 and 103 rejections based on Greener alone and Greener in view of White.

The Applicants acknowledge the double patenting rejection based on U.S. Patent 6,420,011 and the rejection of Claims 1 and 3-10 as being anticipated by U.S. Patent 6,420,011.

The Applicants respectfully submit that both the double patenting and §102 rejections based on U.S. Patent '011 are inapplicable. Independent Claim 1 recites that the biaxially oriented polyester film has a surface roughness (Ra) in the range of 10nm to 140nm. The Applicants respectfully submit that U.S. '011 does not disclose, teach or suggest this claimed aspect of the invention. Although the biaxially oriented polyester films of U.S. '011 have proven to be useful in a variety of aspects, such films have no application here. The reason is that there is utterly no disclosure concerning the claimed roughness.

The Applicants note with appreciation the Examiner's helpful identification of the location upon which the rejection is based as it applies to the claimed surface roughness (Ra). The Applicants' attention was drawn to column 15 at line 42 for a surface roughness teaching in the range of 10 nm to 140 nm. However, the Applicants respectfully submit that the language in column

15 actually does not apply to the film, but instead, applies to the guide pin utilized in the high speed abrasion resistance test. The entire sentence at issue is reproduced below:

A ½ inch wide tape obtained by slitting a film was run on a guide pin (surface roughness: 100 nm as Ra) using a tape runability tester (running speed 250m/min, 1 pass, rap angle 60°C. running tension 90g).

It can be seen that the terms enclosed within the parentheses in both locations of that above sentence refers to the language immediately in front of the parentheses. Thus, the “running speed 250m/min... running tension 90g” is a descriptor of the tape runability tester. Similarly, the surface roughness language within the parentheses is a descriptor of the guide pin. The surface roughness does not apply to the half inch wide tape.

The Applicants also note with appreciation the Examiner’s helpful comments indicating that U.S. ‘011 teaches the film being stretched in the machine direction at a ratio of 3.0 to 10 and also discloses a breaking frequency of the film. As such, the Examiner’s comments further indicate that one of ordinary skill in the art would have readily determined the elongation in the break of the machine direction depending on the desired end result. However, the Applicants respectfully submit that elongation at break is completely different from the breaking frequency of the film. These are totally different physical characteristics on the one hand. On the other hand, those of ordinary skill in the art are fully aware that it is most difficult indeed to determine the elongation at break from the stretching ratio in the machine direction and the breaking frequency of the film. These are not readily interchangeable characteristics that readily lend themselves towards determining one or the other based on the knowledge of one or the other.

In the case of a breaking frequency of the film, the stretch temperatures of stretching in the machine direction and the stretch temperature of stretching in the transverse direction are 95°C or more as described in the temperature column in Table 1 of the Applicants’ Specification. On the other hand, page 30 of the Applicants’ Specification shows that the temperature of an elongation at break is 23°C in the measuring environment of elongation at break.

The temperature of stretching or elongating film differs greatly. Moreover, the kind of stretching or elongating film differs greatly. The film breaks occur during the process of stretching in the machine direction or in the transverse direction. When the film break occurs during the process of stretching in the machine direction, the kind of film is a nonstretched film or a mono-axial

stretched film. When the film break occurs during the process of stretching in the transverse direction, the kind of film is a mono-axial stretched film or a biaxial stretched film which are not heat treated.

The films for measurement of elongation at break of this case are produced as described in the Examples or Comparative Examples. The films for measurement of elongation at break are biaxial stretching films which are heat treated. The Applicants therefore respectfully submit that U.S. '011 is also inapplicable and cannot support the double patenting rejection and/or the §102 rejection. Withdrawal of both rejections is accordingly respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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